

Atty Matter No. 0276492
Atty Reference No. 23521-0107

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Patent Application of:)
Vassilios Papadopoulos et al.)
Application No. 09/047,652)
Filed: March 25, 1998)
For: PERIPHERAL-TYPE BENZODIAZEPINE)
RECEPTOR: A TOOL FOR DETECTION,)
DIAGNOSIS, PROGNOSIS, AND)
TREATMENT OF HUMAN BREAST)
CANCER)

Group Art Unit: 1642
Examiner: M. Davis

17
02/20/01

REPLY PURSUANT TO OFFICIAL ACTION
IMPROPERLY HOLDING OCTOBER 12, 2000 REPLY NON-RESPONSIVE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Reply is responsive to the January 18, 2001 letter. In response to this Official Action, which this should not be necessary, kindly cancel Claims 58-62. As a result of this amendment, all the current are directed to an isolated, biogenetically pure antisense oligonucleotide that possesses a structure complementary to PBR receptor DNA sequences, and which inhibits the expression of the PBR gene.

In the most recent Official Action, the Examiner improperly held Applicants' October 12, 2000 Reply non-responsive. Particularly, she asserted that all the claims submitted with the most recent Reply are directed to a non-elected invention. However, this is not the case.

Indeed, Applicants' previous Reply dated December 15, 1999 contained Claim 50 directed to an antisense oligo complementary to PBR RNA or DNA that inhibits the expression of PBR. Moreover, the claim was treated on the merits and rejected in the April 12, 2000 Official Action under §112, first paragraph, and under §103 based on prior art.

In response to such rejection, Applicants narrowed their claims such that they are directed to antisense oligos complementary to PBR sequences having express support in the disclosure. Moreover, when they submitted such amendments, Applicants were not under

*REPLY TO OFFICIAL ACTION*U.S. Serial No. 09/047,652

Page 2

final rejection. Accordingly, it is not seen how the previous Amendment was improper as quite clearly, Applicants submitted a Reply with numerous claims corresponding to an invention previously elected and treated on the merits. While it is understood that the Examiner perhaps did not search for these specific sequences, they were part of the disclosure. Also, the disclosure made clear that these sequences correspond to PBR (see pp. 15-16 of the application).


Accordingly, in construing the claims, it should have been apparent that antisense oligonucleotides corresponding to these sequences constituted subject matter directed to an invention already searched and examined. Indeed, it is unclear how the Examiner could have construed the claimed PBR antisense oligos absent a search of SEQ ID NOS:1 or 2.

However, in any event, Applicants did not submit an improper Reply.

If the Examiner has any questions with respect to this application, please contact the undersigned attorney of record at the telephone number listed below.

Respectfully submitted,

PILLSBURY WINTHROP L.L.P.

By: 
Robin L. Teskin
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Date: February 20, 2001

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TO: UNITED STATES PATENT AND TRADEMARK OFFICEFACSIMILE #: (703) 308-4227No. Pages (Including this page) 5 FAX Opr: K. HutchisonFEB 21 2001
GROUP 1600

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In re PATENT APPLICATION of

Inventor(s) Vassilios Papadopoulos et al.Appln. No. 09/047,652Group Art Unit: 1642Examiner: M. Davisseries code ? ↑ serial no.Filed: March 25, 1998Atty. Dkt. PM 0276492

M#

TITLE:

Peripheral-Type
Benzodiazepine Receptor: A
Tool for Detection,
Diagnosis, Prognosis, and
Treatment of Human Breast
Cancer

Date: February 20, 2001Name or type of signed paper being transmitted:Reply to Official ActionMESSAGE:

Please see the attached Reply to the January 18, 2001 Official Action.

Thank you.

(ATTN: Atty/Sec.: Transmit only one paper herewith. For papers not acceptable by fax, see back side or IAN
Forms Directory PAT-286 Rear. Do not file originals but fasten them in our file (left side) with
this sheet and fax receipt on top. Do NOT send the originals nor a confirmation copy to the PTO.)

CERTIFICATE OF FACSIMILE TRANSMISSIONI hereby certify that this paper is being facsimile transmitted to the Patent
and Trademark Office on the date shown below.Name Robin L. Teskin Sig. R. L. Teskin Date February 20, 2001082137/0276492

C# / M#

Inventor(s): Vassilios Papadopoulos et al.

Appl. No.: 09 047,652

Series Code ↑

Serial No. ↑

Filed: March 25, 1998

Hon. Commissioner of Patents
Washington, D.C. 20231

Sir:

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FEB 21 2001

Group Art Unit 1642

Examiner: M. Davis

Atty. Dkt. PM 0276492 23521-0107

M#

Client Ref

Appl. Title: Peripheral-Type Benzodiazepine
Receptor: A Tool for Detection,
Diagnosis, Prognosis, and Treatment of
Human Breast Cancer

REPLY/AMENDMENT/LETTER GROUP 1600

Date: February 20, 2001

This is a reply/amendment/letter in the above-identified application and includes the herewith attachment of same date and subject which is incorporated hereinto by reference and the signature below is treated as the signature to the attachment in absence of a signature thereto.

FEE REQUIREMENTS FOR CLAIMS AS AMENDED

1. Small Entity claim

- A. ☐ NOT made
B. ☐ Withdrawn
C. ☐ made herewith
D. ☒ made previously

For B & C
See Required
Separate Paper
(Pat-256)

Claims remaining after amendment	Highest number previously paid for	Present Extra	Large/Small Entity	Additional Fee	Fee Code Lg/Sm
2. Total Effective Claims	**minus 0	0	x \$18/\$9 =	+ \$0	103/203
3. Independent Claims	***minus 0	0	x \$80/\$40 =	+ \$0	102/202
4. If amendment enters proper multiple dependent claim(s) into this application for first time (leave blank if this is a reissue application) add			+ \$270/\$135 =	+ \$0	104/204
5. Original due Date: February 18, 2001 <input type="checkbox"/> NONE					
6. Petition is hereby made to extend the original due date to cover the date this response is filed for which the requisite fee is attached		(1 mo) \$110/\$55 = (2 mos) \$390/\$195 = (3 mos) \$890/\$445 = (Usable only for ≤ 2mo.OA --- 4 mos) \$1390/\$695= (Usable only for 30 day/1mo.OA --- 5 mos) \$1890/\$945=	+ \$0		115/215 116/216 117/217 118/218 128/228
7. Enter any previous extension fee paid since above original due date and subtract			- \$0		
8. Extension Fee Attached			+ \$0		
9. If Terminal Disclaimer attached, add Rule 20(d) official fee			+ \$110/\$55	+ \$0	148/248
10. If IDS attached requires Official Fee under Rule 97 (c), or if Rule 97(d) Request add			+ \$180	+ \$0	126
11. After-Final Request Fee per rules 129(a) and 17(r) add			+ \$180	+ \$0	126
12. No. of additional inventions for examination per Rule 129(b)			+ \$710/355	+ \$0	146/246
13. Request for Continued Examination (RCE)			x \$710/355 ea	+ \$0	149/249
14. Petition fee for			+ \$710/355	+ \$0	1179/1279
15. TOTAL FEE ENCLOSED =			\$0		

16. *If the entry in this space is less than entry in next space, the "Present Extra" result is "0".

17. **If the "Highest number previously paid for" in this space is less than 20, write "20" in this space.

18. ***If the "Highest number previously paid for" in this space is less than 3, write "3" in this space.

Our Deposit Account No. 03-3975)

(Our Order No. 082137 0276492

C#

M#

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This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an Issue fee transmittal sheet is filed.

Query: Is appeal deadline now? If so, file Notice of Appeals separately.

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NOTE: File this cover sheet in duplicate with PTO receipt (PAT-103A) and attachments